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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/015,191

11/21/2001

Stephen J. Padden

HM-69621

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09/06/2006

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EXAMINER

TRUONG, THANH K

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,191

Applicant(s)

PADDEN, STEPHEN J.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11,21 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 21 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2006 has been entered.
2. Applicant's cancellation of claims 7, 12-20, 22-25, and 27-29 is acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-6, 8-11, 21 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, the recitation "said two sidewalls and said bottom wall together forming an opening an opening in said bottom wall and opening in said sidewalls" (lines 8-9) is vague and indefinite, because it is unclear and confusing. It is unclear what is the structure limitation is being claimed. A recess or an opening at a corner of a housing is formed when there are no sidewalls or there is no bottom, therefore, to say that the sidewalls and the bottom wall together forming an opening is confusing.

Claim 1 recites the limitation "stapler member" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 21, the recitation "a detachable stapler comprising a base and two side surfaces joining said side walls to one another" (lines 4-5) is vague and indefinite, because it is unclear what is joining the side walls to one another.

Claim 21 recites the limitation "said side walls" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfe (4,014,493).

Wolfe discloses (figures 12 & 13) an apparatus comprising:

a housing (22, 41) having a periphery that includes a bottom wall and two parallel sidewalls connected orthogonally to, and spaced apart from one another by a bottom wall (figures 12 and 13);

a corner recess formed at the corner of the housing in the two parallel sidewalls and in the bottom wall (the recess to accommodate the stapler);

a stapler (the portion that fits into the recess of the housing) comprising a hinged end from which extend a stapler base and an activating member and a stapler open end (slot 24) for receiving materials to be stapled, wherein the stapler base lies substantially flush with and forms a portion of the bottom wall and the sides of the stapler lie substantially flush with and form portions of the two parallel sidewalls, substantially filling the recess, and the stapler is releasably secured to the housing in a manner to position the stapler open end at the corner recess (figures 12 & 13).

Wolfe further discloses (figures 12 & 13): the housing side wall opening and bottom wall opening comprise a recess in the housing peripheral walls and the stapler is fitted into the recess; the peripheral walls include a bottom wall into which extends the bottom wall opening and side wall into which extends the side wall opening, the base of the stapler being about coplanar with the bottom wall; the open end of the stapler is proximate to the side wall; the stapler has an outline and the peripheral walls include a corner with a recess having a shape that corresponds to the outline; and the stapler being fitted into the recess.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (4,014,493) in view of Padden (6,009,584).

As discussed above in paragraph 6 of this office action, Wolfe discloses the claimed invention, but does not expressly disclose the recess for the stapler as recited in claims 2-6 and 8, however, it is well known in the art to create recess in the housing of the multiple-purpose tool holder in such a way that the recess accommodates the shape and size of the tool being inset to the housing. The recess comprises slot, curve portion, flange, tab, etc.

Padden's disclosure supports the contention that it is well known in the art to create recess in the housing of the multiple purpose tool holder with varieties of shapes and sizes to accommodate varieties of tool. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have combined Wolfe and Padden, and modified Wolfe by incorporating the creation of recesses in the housing of the multiple-purpose tool holder to fit different tools as taught by Padden.

As for a hole punch to fit an opening at the corner opening in the tool housing as recited in the claims 9 and 10, the examiner takes official notice that it is within the skill of one in the art to provide a hole puncher in the multiple purpose tool holder providing a complete stationery tool set.

Regarding to claim 9, the applicant has not challenged the examiner's taking the Official Notice (Office action dated December 15, 2004). Therefore, the examiner's

position (regarding the rejection of claim 9) is maintained and the subject matter, per se, of claim 9 is deemed admitted prior art.

9. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (4,014,493) in view of Ng (6,145,994).

As discussed above in paragraph 6 of this office action, Wolfe discloses the claimed invention, but does not expressly disclose a lighting means mounted within the housing and oriented for illumination through the aperture, and an activation means to illuminate the lighting.

Ng discloses an apparatus comprising lighting means (30) mounted within the aperture and an activation means (28) to illuminate the lighting, Ng apparatus provides the multiple-purpose tool holder with lighting capability. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Wolfe by incorporating the lighting apparatus as taught by Ng providing the multiple-purpose tool holder with lighting capability.

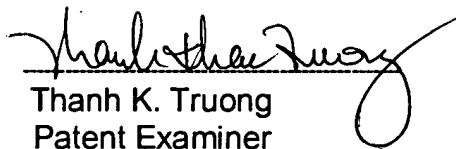
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thanh K. Truong
Patent Examiner
September 3, 2006.